

REMARKS

Claims 1-5, 7-12, 14-19, 21, 22 and 25 are pending in the above-identified application. Claims 16-19 are objected to because of informalities. Claims 15-19 are rejected under §101 as being directed to non-statutory subject matter. Claims 1-5, 7-12, 14-19, 21, 22 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gulati et al. (U.S. Pat. No. 6,924,827; hereinafter referred to as "Gulati") in view of Shunichi (Publication of Japanese Application 2003-256438) and further in view of Denoue (U.S. Pat. Pub. No. 2003/0051615).

Applicants submit that these amendments and remarks overcome all of the Examiner's outstanding objections and rejections and bring the present Application into condition for allowance. Entry of this amendment and a notice of allowance of all the remaining claims are therefore respectfully solicited.

Objections to the Claims

Claims 16-19 are objected to because of informalities. Claim 15 is amended to correct a minor issue with antecedent basis that affected claims 16-19. Specifically, the term "program" has been replaced with the term "programming." Applicants submit that this change does not affect the scope of the claims. Applicants therefore respectfully request withdrawal of the objections to claims 16-19.

Rejections Based on §101

Claims 15-19 are rejected under §101 as being directed to non-statutory subject matter. Paragraph [0016] has been amended to remove references to "memory" that "contains," "communicates," "propagates," or "transports." Applicants submit that recording medium that "stores" eliminates any claim to transmission medium and is thus statutory. Therefore, Applicant respectfully requests withdrawal of the §101 rejections of claims 15-19.

Rejections Based Upon 35 U.S.C. §103(a)

Claims 1-5, 7-12, 14-19, 21, 22 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gulati in view of Shunichi and further in view of Denoue. Independent claims 1, 8, 15, 21 and 25 are amended to clarify that the “metadata and the additional metadata inserted into the second document is accessible from the first document,” which Applicants submit the cited art does not teach or suggest.

The current Office Action dated July 17, 2008, (O.A.) concedes that Gulanti and Shunichi “do not teach ‘inserting the metadata into a second destination document, wherein the second destination document is associated with the first destination document’” (p. 6, lines 5-7). The O.A. relies upon Denoue for this particular element, however, Denoue is directed to a system for “freeform printing” (Abstract) rather than the storing of information per se. The portion of Denoue relied upon for “metadata and the additional metadata inserted into the second document,” with the relevant section underlined, is as follows:

Each element that is printed with the printing device and/or scanned into the printing device is assigned a unique identifier. At the user's request, this identifier is printed along with the content as a barcode or other identifier. The barcode may be a one; two or multidimensional barcode or any other known or later developed identifier. By scanning this identifier, the user can retrieve properties associated with the identifier. Example properties that can be included in matadata are for example, the content of the data information itself, the date, the time, the link to the source from where the content was selected, or any other known or later developed data information. After scanning an identifier, the user can print data information referenced by the identifier elsewhere. The user can also send the entire identifier or properties associated with the identifier to host computers like PDAs, cellphones, etc. using any known or later developed communication techniques

(¶[0091, lines 3-20). The O.A. relies upon the fact that Denoue prints the information elsewhere to suggest Applicants’ “inserting the metadata and the additional metadata into

a second destination document.” Firstly, the O.A. misconstrues “printing” and “inserting” and, secondly, claims 1, 8, 15, 21 and 25 have been amended to clarify that, unlike the printed information described in Denoue, the claimed subject matter enables a user to access the second destination document from the first destination document. This feature is supported in Applicants’ Specification by the very nature of the disclosed technology in which the “system stores the information as metadata so that the user or a subsequent user of the destination document can, when necessary, access the metadata” (Abstract). The feature of accessing from the first destination document is supported by Figures 3 and 4 and the supporting description, which describes the cutting of material and metadata from one document and the pasting of the material and metadata into another.

With respect to claims 7 and 14, the O.A. relies upon Guilanti “wherein metadata such as bibliographic data is only viewable when requested by the user” (p. 8, lines 9-10). Applicants submit that, if data is viewable when requested by a user, the data is viewable. Thus, Guilanti does not suggest this element of Applicants’ claimed subject matter because the data is viewable, which is clearly outside the plain meaning of the claims.

To establish *prima facie* obviousness of a claimed invention under §103(a), all the claim limitations must be taught or suggested by the prior art. (M.P.E.P., §2143.03, citing *in re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974)). In addition, “**All words in a claim must be considered in judging the patentability of that claim against prior art.**” (*Id.*, citing *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970); *emphasis added*). Applicants believe that the cited art fails to meet this standard. For the reasons above, claims 1-5, 7-12, 14-19, 21, 22 and 25 are allowable over the cited art. In addition to the reasons stated above, claims 2-4, 8-12, 14, 16-19 and 25 are allowable because each depend upon one of the allowable independent claims. Therefore, Applicants respectfully request withdrawal of the §103(a) rejections of claims 1-5, 7-12, 14-19, 21, 22 and 25.

CONCLUSION

In light of the amendments and remarks made herein, Applicants submit that all pending claims are allowable and earnestly solicits notice thereof. Applicants are not conceding in this application that the unamended claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution of the allowable subject matter. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications. A Request for a One-Month Extension of Time to file this Amendment by November 17, 2008 is being filed and paid for concurrently with this filing. It is believed that no other fees are due with the filing of this Amendment/Response. However, should any other fees be due, the Commissioner is hereby authorized to charge such fees to the deposit account of IBM Corporation, Deposit Account No. 09-0447.

Respectfully submitted,

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